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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,245	12/13/2001	Bin Takigawa	S002-4503	1504

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EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

2705

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/017,245	TAKIGAWA, BIN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Judy M. Reddick	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 August 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 18 is/are withdrawn from consideration.
- 5) Claim(s) 3,8 and 15 is/are allowed.
- 6) Claim(s) 1,2,4-7,9,10,12-14,16 and 17 is/are rejected.
- 7) Claim(s) 3,8 and 15 is/are objected to.
- 8) Claim(s) 1-18 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

**Election/Restrictions**

1. Newly submitted claims 11 and 18 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The originally presented invention(claims 1-10 & 12-17) is drawn to a coating solution and a method for producing a coating solution. The newly presented invention(claims 11 and 18) are drawn to a method of coating an article. The inventions are separate and distinct, each from the other, as per having been related as mutually exclusive species, each not requiring the particulars of the other for patentability. The product resulting from the process of the originally presented invention is substantially different from the product resulting from the process of the newly presented invention. Furthermore, the product(coating solution) of the originally presented invention and the method of coating an article per the newly presented invention are related as product and process of using. In the instant case the coating solution can be used in an entirely different process such as a process for coating a substrate other than fabric, paper or leather such as a plastic or glass substrate.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11 and 18 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 10 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A) The recited "terpenic oil" per claims 5 and 10 constitutes indefinite subject matter as per it not being readily ascertainable as to the exact meaning intended since the suffix "ic" translates to "having the characteristic of", i.e., the metes and bounds of "terpenic" engender indeterminacy in scope.
- B) The recited "wherein the first and second solvents" per claim 17 constitutes indefinite subject matter as per the non-express establishment of proper antecedent basis.

**Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 2, 4-7, 9, 10, 12-14, 16 & 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollub et al(U.S. 3,150,048) in combination with Machac, Jr. et al(U.S. 6,420,327 B1).

Hollub et al teach a nail lacquer removing preparation which is defined basically as containing a) an organic lacquer solvent, b) an internally plasticized polymer and ,optionally, c) a lipophilic ingredient, wetting and/or dispersing agent or a thickener(col. 1, lines 20-39). Hollub et al @ col. 1, lines 40-55 and col. 2, lines 16-19 and 53-58 also teach that as lacquer solvents there

Art Unit: 1713

may be used the water-soluble or sparingly soluble or water-insoluble organic solvents customarily used for dissolving nail lacquers especially nitro cellulose nail lacquers, such as acetone, methyl ethyl ketone(butanone), ethyl acetate, isopropyl acetate, butyl acetate, amyl acetate, benzyl acetate, methylglycol acetate or ethyl glycol acetate and, in addition, a small proportion of another organic solvent as diluent, such as toluene, a chlorinated hydrocarbon or benzine(ligroin) and that the internally plasticized (co)polymers are preferably those of esters of at least copolymerizable acids such as (meth)acrylic acid and advantageously homo- or copolymers of esters of (meth)acrylic acid in an amount of about 0.5 to 5% based on the total weight of the nail lacquer. Hollub et al further teach @ col. 2, lines 59-65 that the nail lacquer removing preparations may be in the liquid form, i.e., as a simple solution of a small proportion such as 1-5 % of (co)polymer in a lacquer solvent or mixture of lacquer solvents and, in a preferred form, the nail lacquer removing preparation is in the form of a paste prepared by homogenizing a solution of the polymer or copolymer in the lacquer solvent with a lipophilic ingredient and/or a thickener. Hollub et al @ col. 3, lines 9-14 and 25-30 teach that the use of finely divided SiO<sub>2</sub> in a proportion of about 1 to 10 %, based on the weight of the preparation, has the special advantage that the nail lacquer removing preparation can be prepared with the aid of lipophilic ingredients in the form of a semi-transparent jelly and that suitable lipophilic ingredients include fat-restoring fatty acid esters such as isopropyl palmitate or isopropyl myristate. Hollub et al further teach @ col. 3, lines 30-39 that to enhance the gloss, there can be added a small proportion of a silicone oil and that the nail lacquer removing preparation can contain d) customary additives for use in cosmetics such as perfumes, dyestuffs, or the like.

See col. 1-6, Runs and claims inclusive and especially Runs 6 & 7.

The disclosure of Hollub et al differs basically from the claimed invention as per the non-express disclosure of an embodiment authorizing the use of and amide compound such as a formamide, acetamide or formohydrazide compound, as claimed, in the nail lacquer removing preparations.

Machac, Jr. et al @ col. 3, lines 37-67 to col. 4, lines 1-14 teach the use of conventional adjuncts in coating removal preparations such as varnishes wherein, said conventional adjuncts include surfactants/emulsifiers, to increase the wetting properties, in an amount of from about 0.1 to about 10 % by weight such as alkyl sulfonamides, cetyl palmitic alkanol amides, etc. and common organic co-solvents such as formamide, dimethyl formamide, acetamide, dimethylacetamide, methyl ethyl ketone, etc.

Therefore, it would have been obvious to the skilled artisan to swap the amide-containing surfactants/emulsifiers of Machac, Jr. et al for the wetting/emulsifying agents of Hollub et al, based on their recognized equivalence in scope, and with a reasonable expectation of success. By the same token, it would have been obvious to the skilled artisan to swap the organic amide co-solvents of Machac, Jr. et al for the co-solvents of Hollub et al, based on their recognized equivalency in scope, and with a reasonable expectation of success. Criticality for such, clearly commensurate in scope with the claims, not having been demonstrated on this record.

As to the utility of the amide compounds as a clearing agent, since the amide compound is essentially the same as the inventive amide compound it must necessarily possess the claimed properties. Moreover, is not necessary in order to establish a *prima facie* case of obviousness that there be a suggestion or expectation from the prior art that the claimed compound will have the same or a similar utility as one newly discovered by applicant. Consult *In re Dillon* 16 USPQ2d 1897. See also *In re Papesch*, 315 F.2d 381, 391, 137 USPQ 43, 51 (CCPA 1963), a compound and all its properties are inseparable.

#### Response to Arguments

7. Applicant's arguments filed 08.12.03 have been fully considered but they are not persuasive.

Relative to the 112, 2<sup>nd</sup> paragraph issue--Counsel argues that the term "terpenic oil" is well known as will be revealed by a simple Internet search of the term and, to this end, it is immaterial whether similar claims have been allowed to others. *In re Giolito et al.*, 188 USPQ 645. See *In re Margaroli*, 50 CCPA 1400, 318 F.2d 348, 138 USPQ 158 (1963); *In re Wright*, 45 CCPA 1005, 256

Art Unit: 1713

F.2d 583, 118 USPQ 287 (1958); In re Launder, 41 CCPA 887, 212 F.2d 603, 101 USPQ 391 (1954).

**Allowable Subject Matter**

8. Claims 3, 8 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

9. The prior art Shinohara et al(U.S. 5,425,804) is cited as of interest in teaching the use of a combination of fatty acid compounds in water-repellent compositions comprising a solution of a silicone oil. A rejection, in the future, may be made based on this prior art. Since a valid rejection exists on the record, a rejection at this time is not being made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

*Judy M. Reddick*  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR *[Signature]*  
11.6.03